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6/18/03

Attorney's Docket No. 003300-570

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)
Björn HEED et al.) Group Art Unit: 2675
Application No.: 09/319,222) Examiner: D. Chow
Filed: August 23, 1999) Appeal No.
For: VIEWING INSTRUMENT)

BRIEF FOR APPELLANT

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Commissioner for Patents
P.O. Box 1450
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Sir:

This appeal is from the decision of the Primary Examiner dated February 24, 2003 (Paper No. 14), finally rejecting claims 21-40, which are reproduced as an Appendix to this brief.

A check covering the [X] \$160.00 (2402) [] \$320.00 (1402) Government fee and two extra copies of this brief are being filed herewith.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

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I. Real Party in Interest

The present application is unassigned, and hence the inventor is the real party in interest.

II. Related Appeals and Interferences

The Appellants' legal representative and Appellant do not know of any other appeal or interference which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

Claims 1-20 were canceled on September 16, 2002 and replaced with new claims 21-40. All of these pending claims 21-40 have been finally rejected and are appealed.

IV. Status of Amendments

No amendments have been filed subsequent to the issuance of the final Office Action.

V. Summary of the Invention

The present invention relates to distance viewing instruments, such as handheld viewing instruments including binoculars and monoculars. The present inventor has noted that holding handheld distance viewing instruments can provide insufficiently stable images of distant objects. The slightest shaking movement of the distance viewing instrument causes the image viewed by the user to shake. When there is a high degree of magnification, the shaking movements affect the image to such an extent that perception thereof is difficult. See page 1, lines 1-12, as well as page 4, line 31-page 5, line 7, for instance. This limits the practical range of magnification for handheld viewing instruments to 7 or 8, and rarely above 10. Page 1, lines 9-12.

Additionally, it could be difficult for the user to locate relatively small objects against a relatively large background when using high magnification instruments. High magnification reduces the field of vision.

Accordingly, the present invention overcomes one or both of the problems due to the shaking motions and the difficulties in finding target objects. This is achieved by the possibility of freezing the image provided by a distance viewing instrument. The frozen image may then be studied and can be magnified in one embodiment without the inconvenience of shaking movements.

As articulated in appealed claim 21, the distance viewing instrument includes an optical system (1, 2, 4 and 5) for viewing distant objects and providing live images of the objects. It also includes a memory function (Electronic Processing Unit 3) to freeze a live image being viewed by a user.

In claim 22, it is further developed that the distance viewing instrument has means to magnify the frozen image being viewed by the user relative to the image before being frozen which, as articulated in claims 23 and 24, can include control means for image freezing and means for time interval freezing.

As articulated in claim 26, for instance, there is a second embodiment in which an electronic retina is arranged to be optically or mechanically exposed to receive different-size images from the optical system in such a manner that the frozen image being viewed is a larger size on the display screen than a non-frozen image having a larger angle of vision.

Other claims, such as claims 27 and 28, for instance, define instruments that could be described as binoculars.

VI. The Issues

Issue A: Whether claims 21, 23-25, 27-29, 33, 38 and 40 are rendered unpatentable under 35 U.S.C. §103 over the *Nishimura* patent (U.S. Patent No. 5,270,810); and

Issue B: Whether claims 22, 26, 30-32, 34-37 and 39 are unpatentable under 35 U.S.C. §103 over the *Nishimura* patent in view of the *Branson* patent (U.S. Patent No. 5,740,801).

VII. Grouping of Claims

For Issue A, at least claims 21 and 23-25 do not stand or fall with claims 27-29, 38 and 40 insofar as the art being applied does not suggest embodiments that could be broadly categorized as binoculars being made out of devices presented in the prior art, for reasons explained below.

With respect to Issue B, at least claims 26, 35 and 36 do not stand or fall with claims 22, 30-32 and 34, and claims 37 and 39 do not stand or fall with the other claims 22, 26, 30-32 and 34-36, insofar as they are directed to binoculars or a distance viewing instrument for both eyes, for the reasons explained below.

VIII. Argument

A. The Examiner's Interpretation of the Term "Distant" is Unreasonable

The present invention includes an optical system for viewing distant objects and providing live images of those objects. This feature of the claims is not found in the applied art, and in particular, the *Nishimura* patent.

1. The *Nishimura* Patent

The *Nishimura* patent is directed to an endoscope, which of course does not view distant objects. It is designed to provide a video signal while providing a still image memory of internal body parts. A switch allows the user to selectively supply signals to the image memory as output signals.

Because an endoscope is not a distance viewing device, claims 21, 23-25, 27-29, 33 and 40 are not anticipated thereby. Further, there is no reason in the prior art to modify an endoscope to perform this function. To do so would completely be contrary to the overall

purpose of endoscopes, which is to view near objects. Where the proposed modification would render the applied prior art unsatisfactory for its intended purpose, a *prima facie* case of obviousness cannot be established. *In re Gordon*, 733 F.2d 100, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

The Examiner suggests, however, in the final Office Action of February 24, 2003, that "the claimed distance viewing instrument required [sic] is a viewing instrument which views an object from a distance regardless length [sic] of the distant [sic]. This feature is obviously met by Nishimura's viewing instrument." In the context of the present application, it is respectfully submitted that the Examiner's interpretation of the term "distance" in the context of the claims and the specification, is unreasonable.

Appellants have pointed out that the present invention involves a distance viewing instrument such as used for viewing birds and airplanes against the sky, as mentioned at page 1 of the present specification. The *Nishimura* patent, in marked contrast, is an endoscope, which does not view distant objects. An endoscope is a form of microscope for viewing objects that are very close to an objective lens.

The Office need look no further than its own Classification Definitions for this understanding. The Classification Definition for class 359, subclass 368, for instance, regarding microscopes, is that the subject matter is "designed to focus highly divergent light from an object very close to the objective." This is in contrast to the Classification Definition for class 359, subclass 399, regarding telescopes, of which binoculars and monoculars such as in the present invention, are species, which includes the words "wherein the compound lens system is designed for viewing distant objects." [Emphasis added.] Insofar as the Appellant is using the very same terminology utilized by the U.S. Classification Definitions for distinguishing telescopes from microscopes, it is respectfully submitted that the Office should accept this term to mean what it is accepted to mean in the industry and in accordance with the present specification, i.e., an instrument that views objects at a distance rather than very close to an objective lens, such as an endoscope.

It is often stated that during patent examination, the pending claims must be given the "broadest reasonable interpretation consistent with the specification." See MPEP §2173.05(a) citing *In re Morris*, 127 F.3d 1048, 1054, 44 U.S.P.Q.2d 1023, 1027 (Fed. Cir. 1997); *In re Prater*, 415 F.2d 1393, 162 U.S.P.Q. 541 (CCPA 1969). Here it is also stated that the "broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach." See, MPEP §2111 citing *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). It is respectfully submitted that the Classification Definitions and common knowledge would indicate that a distance viewing instrument would not encompass endoscopes. For this reason alone, Applicant's respectfully submit that the Examiner has made a clear error in the rejection. His interpretation of the word "distance" in the context of the claims is inconsistent with the specification and the use of that term as it would be understood by those skilled in the art, including those skilled in the art that wrote the Classification Definitions for the U.S. Patent and Trademark Office.

For claims such as claims 27, 28, 38 and 40, it is noted that there would be no reason for an endoscope to be in the form of a binocular having two viewing instruments interconnected to each other as claimed in claim 23. The Office offers no comments as to why these claims are rejected and it is submitted that there could be no purpose for forming the endoscopes into distance viewing instruments, let alone binocular distance viewing instruments.

2. Claims 22, 26, 30-32, 34-37 and 39 are Patentable Over the
Nishimura and *Branson* Patents

The *Nishimura* patent is described above. The *Branson* patent is directed to an endoscopic system and therefore the same distinctions exist as with respect to the *Nishimura* patent. Stated differently, even when viewed together, any hypothetical combination of the *Nishimura* device with the *Branson* device would not meet the features of the claims insofar as the result would still be an endoscope. While it may be appropriate, as the Examiner suggests, to use *Branson's* magnifying means in the endoscope of *Nishimura* to magnify a

frozen image, this would still not suggest modifying the endoscope to be a distance viewing device, or the appropriateness of magnifying a frozen image of a distance viewing instrument. In combination, specific limitations of these rejected claims are not described.

This is no more apparent than in the second embodiment of the present invention which includes two displays and two electronic retinas. There is no indication in the prior art of record that using two displays and two electronic retinas in a distance viewing instrument is desirable. The recitations of claims 26, 35 and 36, in particular, there is no suggestion in the applied for a distance viewing instrument which includes an electronic retina that is arranged to be optically or mechanically exposed to receive different-size images from the optical system in such a manner that a frozen image being viewed has a larger size on the display screen than a non-frozen image, the latter image in contrast comprising a larger angle of vision. These claims are separately patentable insofar as there is no suggestion in the prior art for modification to the first embodiment that would achieve the second embodiment of the present invention, and neither embodiment is suggested by the applied art.

B. Improper Assertions of "Official Notice"

The Examiner has made several informal assertions of official notice, such as against claim 24. This notice was timely challenged under MPEP §2144.03. The rejection should not be sustained for the Examiner's failure to support the assertions by supplying a reference in support of his position that claim 24 represents only well known art "capable of instant and unquestionable demonstration" at least to the extent that such a statement would lead one to conclude that claim 24 was unpatentable, for instance.

IX. Conclusion

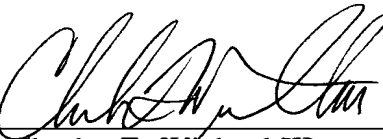
Appellant has specified errors in the rejection and where appropriate specific recitations in the rejected claims which were not described in the prior art relied upon in the rejection. Appellant has also explained how such recitations render the claimed subject matter unobvious over the applied art. Appellant has also explained why the references, taken as a whole, do not suggest the claimed subject matter.

Respectfully submitted,

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Date: June 13, 2003

By: _____


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APPENDIX A

The Appealed Claims

- ✓ 21. A distance viewing instrument, comprising:
an optical system for viewing distant objects and providing live images of said objects;
a memory function to freeze a live image being viewed by a user.
- ✓ 22. A distance viewing instrument as claimed in claim 21, further comprising means to magnify the frozen image being viewed by the user relative to the image before being frozen.
- ✓ 23. A distance viewing instrument as claimed in claim 21, further comprising control means for image freezing.
24. A distance viewing instrument as claimed in claim 21, further comprising means for time-interval freezing of the image.
- ✓ 25. A distance viewing instrument as claimed in claim 21, further comprising at least one electronic retina, at least one electronic display screen and an electronic processing unit providing said memory function, which connects said at least one electronic retina with said electronic display screen.
- ✓ 26. A distance viewing instrument as claimed in claim 21, further comprising an electronic retina that is arranged to be optically or mechanically exposed to receive different-size images from said optical system in such a manner that the frozen image being viewed has a larger size on the display screen than the non-frozen image, the latter image in contrast comprising a larger angle of vision.
- ✓ 27. A binocular comprising:
two viewing instrument as claimed in claim 21 interconnected to each other.

- ✓ 28. A distance viewing instrument for both eyes of a user, comprising:
at least one viewing instrument as claimed in claim 21, and
two display screens, one for each eye and showing substantially the same
image.
- ✓ 29. A distance viewing instrument as claimed in claim 21, further comprising a
depressible button for image freezing.
- ✓ 30. A viewing instrument as claimed in claim 22, further comprising a control
means for image freezing.
- ✓ 31. A distance viewing instrument as claimed in claim 22, characterised in that it
is provided with a depressible button for image freezing.
- ✓ 32. A distance viewing instrument as claimed in claim 22, further comprising at
least one electronic retina, at least one electronic display screen and an electronic
processing unit providing said memory function, which connects said at least one electronic
retina with said electronic display screen.
- ✓ 33. A distance viewing instrument as claimed in claim 23, further comprising at
least one electronic retina, at least one electronic display screen and an electronic
processing unit providing said memory function, which connects said at least one electronic
retina with said electronic display screen.
34. A distance viewing instrument as claimed in claim 24, further comprising at
least one electronic retina, at least one electronic display screen and an electronic
processing unit providing said memory function, which connects said at least one electronic
retina with said electronic display screen.

35. A distance viewing instrument as claimed in claim 22, further comprising an electronic retina that is arranged to be optically or mechanically exposed to receive different-size images from said optical system in such a manner that the frozen image being viewed has a larger size on the display screen than the non-frozen image, the latter image in contrast comprising a larger angle of vision.

36. A distance viewing instrument as claimed in claim 23, further comprising an electronic retina that is arranged to be optically or mechanically exposed to receive different-size images from said optical system in such a manner that the frozen image being viewed has a larger size on the display screen than the non-frozen image, the latter image in contrast comprising a larger angle of vision.

37. A binocular comprising:
two viewing instrument as claimed in claim 22 interconnected to each other.

38. A binocular comprising:
two viewing instrument as claimed in claim 23 interconnected to each other.

39. A distance viewing instrument for both eyes of a user, comprising:
at least one viewing instrument as claimed in claim 22, and
two display screens, one for each eye and showing substantially the same
image.

40. A distance viewing instrument for both eyes of a user, comprising:
at least one viewing instrument as claimed in claim 23, and
two display screens, one for each eye and showing substantially the same
image.